

REMARKS

In a previous Office Action, the Examiner allowed claims 41-46, 48-56, 58-66, 68-76, and 78-80; and objected to claims 7, 17, 27, and 37 as dependent upon a rejected base claim. In the Final Office Action identified above, the Examiner rejected claims 1, 3-6, 9-11, 13-16, 19-21, 23-26, 29-31, 33-36, and 39-40 under 35 U.S.C. § 103(a) as being unpatentable over Templin et al. (U.S. Patent No. 5,781,550) in view of Aviani, Jr. et al. (U.S. Patent No. 6,532,493); and rejected claims 2, 8, 12, 18, 22, 28, 32, and 38 as being unpatentable over Templin et al. in view of Aviani, Jr. et al., and further in view of Coile et al. (U.S. Patent No. 6,473,406). Based on the following reasoning, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103(a) and the Examiner's claim objections¹.

I. Claim Objections

In the Office Action mailed on July 27, 2004, the Examiner objected to claims 7, 17, 27, and 37 as being dependent upon a rejected base claim. Applicants, in a Reply dated November 29, 2004, placed claims 7, 17, 27, and 37 in independent claim form incorporating all the limitations of the intervening and independent claims from which the claims were dependent. However, the Examiner did not address claims 7, 17, 27, and 37 in the Final Office Action identified above. Accordingly, Applicants submit that claims 7, 17, 27, and 37 are allowable and respectfully request the Examiner to confirm

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

that the objections to claims 7, 17, 27, and 37 have been withdrawn and that claims 7, 17, 27, and 37 are allowed.

II. The Rejection of Claims 1, 3-6, 9-11, 13-16, 19-21, 23-26, 29-31, 33-36, and 39-40 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1, 3-6, 9-11, 13-16, 19-21, 23-26, 29-31, 33-36, and 39-40 under 35 U.S.C. § 103(a) as being unpatentable over Templin et al. in view of Aviani, Jr. et al. because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." (See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).) Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. (See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.)

Further, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and applicant

from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention. M.P.E.P. § 2142.

Applicants submit that the Examiner has not met his burden of establishing a *prima facie* case of obviousness and believe claims 1, 3-6, 9-11, 13-16, 19-21, 23-26, 29-31, 33-36, and 39-40 are allowable over the cited references. However, to expedite prosecution, Applicants propose amending claim 1 as suggested by the Examiner. (See OA at 2-3.)² Specifically, the Examiner stated that “features upon which applicant relies (i.e., a connection between a router 16 and a proxy server 14 that specifically include packet 212 as referenced in applicant’s figure 12) are not recited in the rejected claim(s).” Applicants propose amending claim 1 to incorporate these features.

As discussed in Applicants’ Reply dated November 29, 2004 and incorporated herein, the Examiner has failed to show where Templin et al. and Aviani, Jr. et al. disclose all the elements of claim 1. The Examiner admits that Templin et al. “may be silent or deficient” as to “determining a destination address corresponding to the destination based on the client address.” (See OA at 2.) Nonetheless, the Examiner asserts that using a “broad interpretation” of the word *determined*, Templin et al. does teach “determining a destination address corresponding to the destination based on the client address.” (See OA at 4-5.) Alternatively, the Examiner asserts that Aviani, Jr. et al. “teaches the further limitation [determining a destination address

² The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

corresponding to the destination based on the client address]" at column 6, line 1- column 7, line 16. (See OA at 5.)

Applicants respectfully disagree with the Examiner's characterizations of Templin et al. and Aviani, Jr. et al. The relied-upon portion of the Templin et al. (i.e., col. 7, lines 22-30 and col. 8, lines 9-13) discloses that the gateway receives the address of the untrusted host as part of the packet from the trusted host. Templin et al., col. 7, lines 23-28. That is, the destination address is received as part of the packet. Thus, the Examiner has failed to show where Templin et al. teaches or suggests "determining a destination address corresponding to the destination based on the client address included in the second packet," as recited in claim 1. Therefore, Applicants submit that the rejection of claim 1 is not supported by Templin et al.

Aviani, Jr. et al. is similarly deficient. The Examiner states that Aviani, Jr. et al. teaches "determining a destination address corresponding to the destination based on the client address." (See OA at 5.) The Examiner points to a portion of Aviani, Jr. et al. that discloses the handling of requests specifying a destination platform that requires user authentication through use of a bypass list. (See col. 6, line 24 to col. 7, line 16 of Aviani, Jr. et al. and OA at 5.) The cited portion of Aviani, Jr. et al. also discloses that the bypass list contains client/server pairs (i.e. source and destination addresses) which identify client/server pairs that should be allowed to pass through the caching system without determining whether the requested information is in the cache. (See col. 7, lines 1-4 of Aviani, Jr. et al.) Neither this portion of Aviani, Jr. et al. or any other portion support the Examiner's rejection.

In light of the above remarks, Applicants assert that the rejection of claim 1 is not supported by the cited art and withdrawal of the rejection is respectfully requested.

Further, Applicants submit that examination of these amendments would not involve further search and/or consideration because these amendments are consistent with the Examiner's suggestions. Therefore, Applicants submit that entry of these amendments are proper and respectfully request the Examiner to allow claim 1.

Claims 11, 21, and 31, although of different scope, include elements similar to that discussed above with regard to claim 1. Applicants therefore request the Examiner to withdraw the rejection of claims 11, 21, and 31 for at least the same reasons discussed above with respect to claim 1.

Claims 3-6 and 9-10, 13-16 and 19-20, 23-26 and 29-30, and 33-36 and 39-40 depend from claims 1, 11, 21, and 31, respectively. As explained, the Examiner has failed to show where Templin et al. and Aviani, Jr. et al. teach or suggest the elements of claims 1, 11, 21, and 31. Accordingly, claims 3-6, 9-10, 13-16, 19-20, 23-26, 29-30, 33-36 and 39-40 are allowable over Templin et al. and Aviani, Jr. et al. for at least the same reasons as claims 1, 11, 21, and 31³. Applicants therefore respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

³ As Applicants' remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejection of all claims dependent therefrom, Applicants' silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicants to the Examiner's assertions as to these claims, and Applicants reserve the right to analyze and dispute such assertions in the future.

III. The Rejection of Claims 2, 8, 12, 18, 22, 28, 32, and 38 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 2, 8, 12, 18, 22, 28, 32, and 38 under 35 U.S.C. § 103(a) as being unpatentable over Templin et al. in view of Aviani, Jr. et al. and further in view of Coile et al. because the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 2, 8, 12, 18, 22, 28, 32, and 38 depend from claims 1, 11, 21, or 31, and thus require all the elements of claims 1, 11, 21, or 31. As explained above, claims 1, 11, 21, and 31 are allowable over Templin et al. and Aviani, Jr. et al. Accordingly, claims 2, 8, 12, 18, 22, 28, 32, and 38 are also allowable over these references for at least the same reasons set forth for claims 1, 11, 21, and 31.

Moreover Coile et al. does not make up for the deficiencies of Templin et al. and Aviani, Jr. et al. That is, the Examiner has also failed to show where Coile et al. teaches or suggests at least “determining a destination address corresponding to the destination based on the client address included in the second packet.” Accordingly, the rejection of claims 2, 8, 12, 18, 22, 28, 32, and 38 is unsupported by the cited references. Applicants therefore respectfully request that the rejection of claims 2, 8, 12, 18, 22, 28, 32, and 38 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

IV. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-46, 48-56, 58-66, 68-76, and 78-80 in condition for allowance. Applicants submit that the proposed amendments of claims 1,

2, 10, 11, 12, 20, 21, 22, 30, 31, 32, and 40 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

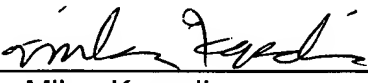
Finally, applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,
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